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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/664,422

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EXAMINER

KOLKER, DANIEL E

ART UNIT

PAPER NUMBER

1649

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/664,422	ROULEAU ET AL.	
	Examiner	Art Unit	
	Daniel Kolker	1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/10/03, 5/16/05</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Applicant's remarks and amendments filed 5 June 2006 have been entered. Claims 14 – 22 are pending.

Election/Restrictions

2. Applicant's election with traverse of SEQ ID NO:65 in the reply filed on 1 June 2006 is acknowledged. The traversal is on the ground(s) that there would not be a serious burden to search all claimed sequences at once. This is not found persuasive because in contrast to applicant's assertion, there would in fact be a serious burden to search all sequences at once. For example, claim 14 encompasses eight sequences, claim 15 encompasses 33 different sequences. Each sequence requires a separate search, and search for any one of these products will not determine if any other product is novel or non-obvious. Each sequence must be separately searched by the USPTO's computers, and given the length of the sequences, searching all sequences now claimed would present a serious burden on the available computer resources.

Applicant also argues that "all claimed sequences relate to the same gene" and therefore should be searched together. However, many of the sequences are of very different lengths and comprise different structural and functional regions. For instance, elected sequence SEQ ID NO:65 is over 9000 nucleotides long, whereas SEQ ID NO:s 69 and 70, both of which are recited in claim 15, are 1380 and 840 nucleotides, respectively. All these sequences, among others, are set forth in claim 15 and are also encompassed by independent claim 14. Searching SEQ ID NO:65 will not reveal whether the much shorter sequences are novel or non-obvious.

Applicant also points to MPEP § 803.04, suggesting that up to 10 independent nucleotide searches should be examined in a single application. Applicant is directed to the text immediately preceding the section he excerpted in his response, which states that

"Polynucleotide molecules defined by their nucleic acid sequence (hereinafter "nucleotide sequences") that encode different proteins are structurally distinct chemical compounds. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq."

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Applicant has not provided any evidence that the nucleic acids are not independent and distinct, and thus the presumption is that they are in fact independent and distinct. Furthermore, applicant did not point out which ten sequences should be examined of the 33 sequences set forth in claim 15.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 14 – 22 are under examination.

Claim Objections

4. Claims 14 – 16 are objected to because of the following informalities: they recite non-elected subject matter. Claim 14 recites eight sequences; the elected invention (SEQ ID NO:65) cannot possibly be in all eight sequences. Claim 15 recites 33 sequences, but only one of them (SEQ ID NO:65) has been elected. Claim 16 recites two amino acid sequences, but the nucleic acid of SEQ ID NO:65 cannot encode them both. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20 – 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are not limited to isolated host cells but rather encompass any cell harboring the requisite vectors. The specification contemplates methods of gene therapy. For example, on p. 25, paragraphs 1 – 3, the inventors contemplate the use of the nucleic acids in pharmaceutical compositions for treatment of disease. In light of the specification, the broadest reasonable interpretation of “a cell” as recited in claims 20 – 22 includes cells within a human being’s body after the person has been treated in a gene therapy protocol. It appears applicant is attempting to claim human beings as his invention; human beings are not statutory subject matter.

Amendment to “An isolated host cell” is recommended to obviate this rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14 – 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the nucleic acid with the sequence of SEQ ID NO:65 and for isolated host cells comprising vectors which include the nucleic acid, does not reasonably provide enablement for all fragments, functional derivatives, or allelic variants as broadly set forth in claims 14 – 16. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

There are many factors considered when determining if the disclosure satisfies the enablement requirement and whether any necessary experimentation is undue. These factors include, but are not limited to: 1) nature of the invention, 2) state of the prior art, 3) relative skill of those in the art, 4) level of predictability in the art, 5) existence of working examples, 6) breadth of claims, 7) amount of direction or guidance by the inventor, and 8) quantity of experimentation needed to make or use the invention. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (FED. Cir. 1988).

In this case, the nature of the invention, which is a nucleic acid that encodes a sodium channel and may be involved in the treatment of epilepsy, is complex. The nucleic acids set forth in claims 14 – 16 are not limited to SEQ ID NO:65, but are sufficiently broad to include any “fragment, functional derivative, or allelic variant thereof.” The breadth of these terms includes essentially any fragment, of any size, or any variant. There is no requirement that any particular protein be encoded by the nucleic acid, or that the nucleic acid itself have any particular use, for example in gene therapy or the like. There is no requirement in the claims that the protein encoded by the claimed fragments, functional derivatives, or allelic variants have any particular amino acid sequence, or that the encoded protein have any particular function.

Given that SEQ ID NO:65 has over 9000 nucleotides, the claims read on an essentially infinite number of possible fragments and derivatives. The claims do not require any function, and the specification does not disclose which regions of the nucleic acid, or of the encoded protein, are critical for any particular function. The specification does not provide guidance as to

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which regions, or "fragment[s]" should be retained, nor is there any requirement in the claims that the fragments, derivatives, or allelic variants have any particular structure or function.

The specification discloses that SEQ ID NO:65 is the nucleic acid sequence of the adult form of SCN3A (see p. 27), which is a sodium channel. The specification also discloses that genomic DNA which encodes SCN3A is sometimes altered in patients with certain forms of epilepsy (see for example pp. 53-54). However, the specification does not teach the artisan how to use the fragments of the nucleic acid now claimed. While "fragments" are not explicitly defined in the specification, a very similar term "DNA segment" is in fact defined on p. 9. Clearly, as contemplated by the inventors, there is no upper or lower limit on the size of the segment or fragment. There is no use demonstrated or even contemplated for fragments as small as, for example, three nucleotides, and there is no requirement that any particular region be retained in the "fragment". Thus the skilled artisan would have to determine how to make the full scope of fragments of the nucleic acids, as well as how to use them. The claims do not require that the nucleic acid fragments, or the protein fragments encoded by them, have any particular activity or function. Given the lack of guidance in the specification commensurate with the scope of the breadth of the term fragments, the artisan would have to determine how to use an unreasonably large number of fragments on his or her own. Such a degree of experimentation, combined with the lack of guidance and dearth of working examples, would be undue.

Furthermore, the specification does not teach the artisan how to make and use a "functional derivative" as recited in claims 14 – 16. This term is defined explicitly in the specification at p. 17, final paragraph. The derivative, according to the definition, must be "substantially similar" in its activity, but there is no definition of how similar it must be, or what specific activities are to be retained. In fact, one could alter a large percentage of the nucleotides in the claimed sequences, and they would still encode some protein with some function. However, there is no reason to believe that the encoded protein would be a sodium channel. As the specification only teaches the artisan how to use sodium channels, and not other proteins, it would be incumbent upon the artisan to discover how to use the "functional derivative[s]" as recited in claims 14 – 16. There is no reason to believe that the protein encoded by the "functional derivative" of SEQ ID NO:65 would be a sodium channel, or that it would have any biological function at all. For example, Rudinger states on page 3 that "it is impossible to attach a unique significance to any residue in a [protein] sequence. A given

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amino acid will not by any means have the same significance in different peptide sequences, or even in different positions of the same sequence". Rudinger further states on page 6 that "the significance of particular amino acid sequences for different aspects of biological activity cannot be predicted *a priori* but must be determined from case to case by painstaking experimental study". Thus in order to determine how to use the functional derivatives as claimed, or the proteins encoded by those functional derivatives, the artisan would have to resort to painstaking experimentation. Given the breadth of the claims and the lack of guidance commensurate with their very broad scope, the degree of experimentation required would be undue.

Similarly, the claims encompass any "allelic variant" of the disclosed nucleic acid. An allele is an alternative form of a gene, which varies from one person to another (see specification p. 19, first complete paragraph). The specification does disclose a few, very specific allelic variants of the SCN3A gene. For example, p. 53 – 54 of the specification discloses that some patients with idiopathic generalized epilepsy have a sequence which comprises SEQ ID NO:401, whereas the normal sequence of the nucleic acid comprises SEQ ID NO:400. Additionally, some patients with epilepsy have a sequence which comprises SEQ ID NO:402, whereas the normal sequence of the nucleic acid comprises SEQ ID NO:401. The claims, however, encompass any allelic variant, whether or not the variant results in a change in amino acid sequence. The variant may be present at any position in the nucleic acid sequence, and may be of any type (insertion, deletion, and substitution). The breadth of "allelic variant" is much greater than the few variants actually disclosed within the specification, and thus the burden would be on the artisan to discover the structures of the allelic variants. Given the lack of guidance in the specification, the artisan would have to discover first how to make the variants, and furthermore the artisan would have to discover how to use these allelic variants, once they had been invented. Given the breadth of the claims and the lack of disclosure of a reasonable number of allelic variants as broadly defined, the artisan would have to resort to an undue amount of experimentation in order to make and use the allelic variants commensurate in scope with the claims.

7. Claims 14 – 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

The claims encompass not only the disclosed nucleic acid sequences, but also any fragment, functional derivative, or allelic variant thereof (see particularly claims 14 – 16). The fragments, derivatives, and variants claimed have not been described in the specification. These variants are essentially without any structural or functional limitation. The skilled artisan cannot envision the structures of the very broad genera of nucleic acids that are claimed.

A genus claim may be supported by a representative number of species as set forth in *Regents of the University of California v Eli Lilly & Co*, 119F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997), which states:

“To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention”. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1980) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”) Thus, an applicant complies with the written description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” Lockwood, 107 F.3d 1565, 1572, 41 USPQ2d at 1966.

An adequate written description of a DNA, “requires a precise definition, such as by structure, formula, chemical name, or physical properties,” not a mere wish or plan for obtaining the claimed chemical invention. Fiers v. Revel, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, “an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself.” Id at 1170, 25 USPQ2d at 1606.” Here, applicant has not described the nucleic acids now claimed, but rather has mentioned that the variants, fragments, and derivatives are part of the invention and has sketched out a method of how the invention could be obtained. Thus claims 14 – 16 clearly fail to comply with the written description requirement. The remaining claims are rejected because they depend from rejected base or intermediate claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 14 – 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Clare et al. (Conference on Molecular and Functional Diversity of Ion Channels and Receptors, New York NY May 14 – 17, 1998, published as Annals of the New York Academy of Sciences 1999. 868:80-83).

The reference cited was published in April 1999, which is without doubt before the earliest possible priority date for the instant application, which is 26 November 1999, the date 60/167623 was published. The full citation, attached to the printed publication, indicates that this is a “Meeting Paper” and that the meeting was held 14 – 17 May 1998, which is more than a year before the earliest possible priority date. The meeting included both oral presentations and poster presentations; the enclosed Table of Contents for the printed volume clearly lists the reference by Clare et al. as a “poster paper” (see Table of Contents for Volume 868, p. 2), as opposed to an oral presentation. The reference thus qualifies as a “printed publication” within the meaning of 35 USC 102(b); see MPEP § 2128.01(IV).

Claims 14 – 15 encompass isolated nucleic acids which comprise SEQ ID NO:65. The specification discloses that SEQ ID NO:65 is the cDNA sequence adult form of human SCN3A (see p. 27 lines 24 – 25), also known as the type III sodium channel. Claim 16 encompasses a nucleic acid that encodes SEQ ID NO:68; as the specification (p. 27) discloses that SEQ ID NO:68 is the amino acid sequence of the adult form of SCN3A, claim 16 necessarily includes the nucleic acid of SEQ ID NO:65.

Clare teaches the cloning of a type III sodium channel from human brain. Specifically, the reference teaches that cDNA libraries from adult cerebellum were used (p. 80, second paragraph) to obtain a full-length cDNA clones. Clare also teaches that while the clones were large and unstable, specific steps were taken to ensure the fidelity of the sequence ultimately obtained. The reference is silent as to the sequence of the nucleic acids. However, the reference provides evidence of the length of the nucleic acid. Clare reports the results of Northern blot experiments, which detected isolated nucleic acids approximately 9.5kb in size.

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Clare reports that these are strongly expressed in brain, and in addition a smaller putative splice variant was also detected in muscle (see p. 83, second and third paragraph, as well as Figure 2). Applicant's SEQ ID NO:65 is 9.1kb long. The prior art product, reported to be "~9.5 kb" appears to be identical to the invention now claimed and necessarily has the sequence of SEQ ID NO:65, as this is an inherent property of the product. Thus the reference by Clare anticipates the products of claims 14 – 16. Once a rejection based upon inherency is made, the burden shifts to applicant to provide evidence distinguishing the product from the prior art; see MPEP § 2112(V).

Claims 17 – 19 stand rejected because the reference by Clare teaches cloning the nucleic acid into a vector (end of second paragraph, p. 80). Furthermore the reference teaches transient transfection of said vector into host cells, meeting the limitations of claims 20 – 22 (see p. 80, third paragraph).

10. Claims 14 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Lu (1998. Journal of Molecular Neuroscience 10(1):67-70, cited on IDS filed 16 May 2005).

Claims 14 – 15 encompass isolated nucleic acids which comprise SEQ ID NO:65. The specification discloses that SEQ ID NO:65 is the cDNA sequence adult form of human SCN3A (see p. 27 lines 24 – 25), also known as the type III sodium channel. Claim 16 encompasses a nucleic acid that encodes SEQ ID NO:68; as the specification (p. 27) discloses that SEQ ID NO:68 is the amino acid sequence of the adult form of SCN3A, claim 16 necessarily includes the nucleic acid of SEQ ID NO:65.

Lu teaches several isolated nucleic acids which encode the human SCN3A protein. Some of the nucleic acids have been submitted to the GenBank database and include accession numbers AF035685 and AF035686 (see abstract). AF035685 is 98.3% identical to SEQ ID NO:65 over the region from bases 2 – 4147, using applicant's numbering. AF035686 is 99.1% identical to SEQ ID NO:65 over the region from bases 2 – 4147, using applicant's numbering. Both sequences comprise many large fragments which are identical to fragments of SEQ ID NO:65. Lu teaches that the nucleic acid called "SCN3A1.1" is part of the SCN3A gene (see p. 68, second column, first complete paragraph), and teaches that this clone, along with clones SCN3A4.3 and SCN3A6.8, cover 4.2kb of the transcribed SCN3A (see paragraph bridging pp. 68 – 69). Thus the isolated nucleic acids taught by Lu are fragments of SEQ ID NO:65, and therefore anticipate the invention of claims 14 – 16. Claims 17 – 19 stand rejected

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as the nucleic acids are cloned into pCR2.1 vector (see p. 68, paragraph bridging the two columns.

Conclusion

11. No claim is allowed.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kolker whose telephone number is (571) 272-3181. The examiner can normally be reached on Mon - Fri 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel E. Kolker, Ph.D.

August 17, 2006



ROBERT C. HAYES, PH.D.
PRIMARY EXAMINER